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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,812	12/28/2000	Charles A. Eldering	T733-10	8268

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME  
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PIPERSVILLE, PA 18947

EXAMINER

MANNING, JOHN

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/750,812

Applicant(s)

ELDERING ET AL.

Examiner

John Manning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the claims being cancelled.
2. Applicant's arguments with respect to claims 18-34 have been fully considered but they are not persuasive.

The Applicant argues that "Bryant does not disclose a system where the subavails are pouped such that the expected viewership of the group is "geater than or equal to the expected viewership of one of the avails." Bryant is completely silent with respect to viewership of any portion of the broadcast signal 300, including the fill segments 320." Bryant discloses the use of targeted advertisements. A targeted advertisement is used to reach a specific audience so as to use the advertisement time as efficiently as possible. It is implicit that a targeted avertisment segment group will have an expected viewership greater than or equal to the expected viewership of any one segment. The "selection of the audience is primarily done by carefully matching advertisements, and other inserted content with a continuing base program. The hope is that audiences are more likely to watch inserted advertisements which closely match the base program content. For example, household products are frequently marketed during soap operas. Likewise, advertisements for motor products are usually matched with motor sports programs. However, the broadcaster has no way to separate audiences interested in new luxury automobiles from those simply interested in motor additives and repair tools" (Col 1, Lines 30-40). "The invention, in part, provides for the

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precise broadcasting of composite programs to targeted audiences. This requires that the base program content, e.g., the movie, the sports-cast, etc., is decoupled from the program fill, e.g., advertisements, public notices, stations breaks, video text overlays, private data, and so forth. Then, each target audience, while viewing the same base program, can be exposed to tailored fill material during program breaks, the fill material especially designed to appeal to the various target audiences based on their diverse demographics." (Col 4, Lines 10-19).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 18 and 29, the parenthetical expression "(avails)" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 18, 21, 27, 29, 31, 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryant et al. (US Pat No 5,652,615).

In regard to claim 18, Bryant discloses a system and method of distributing demographically targeted advertisements. The claimed step of "recognizing one or more advertisement opportunities (avails), each avail having an expected viewership" is met by Figure 1. "Program segments 310 and 320, according to the invention, can be inserted or selected at points 110, 111, 120, 131, 140, 150, 160, 170 of the network 100" (Col 5, Lines 23-25). By inserting the program segments 310 and 320, the system inherently recognizes the advertisement opportunities. The claimed step of "creating a plurality of subavails based on the recognized avails, wherein each of the subavails is directed at a particular target audience group" is met by Figure 1. "The segments are adjacently arranged in a temporal manner, substantially without overlap, and with the base and fill segments alternating" (Col 4, Lines 48-50). "The different fill segments 320 can be separately identified" (Col 5, Lines 10-11). "In a preferred embodiment of the invention, the segments 310 and 320 are separately identified as described below. During distribution of the program, the broadcaster or cable operator can insert segments and select segments based on the identification of the segments. If the selection is done in the STB 200, individual customers can be targeted" (Col 5, Lines 34-39). The claimed step of "aggregating the subavails to generate one or more groups of subavails wherein at least one of the groups of subavails has an expected viewership

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greater than or equal to the expected viewership of one of the avails." is met by Figure

3. "It is proposed that multiple fill segments be concurrently carried on the circuit assigned to the program during their allocated time periods" (Col 5, Lines 4-6).

Therefore, the fill segments or "subavails" are grouped. Bryant discloses the use of targeted advertisements. A targeted advertisement is used to reach a specific audience so as to use the advertisement time as efficiently as possible. It is implicit that a targeted advertisement segment group will have an expected viewership greater than or equal to the expected viewership of any one segment. The "selection of the audience is primarily done by carefully matching advertisements, and other inserted content with a continuing base program. The hope is that audiences are more likely to watch inserted advertisements which closely match the base program content. For example, household products are frequently marketed during soap operas. Likewise, advertisements for motor products are usually matched with motor sports programs. However, the broadcaster has no way to separate audiences interested in new luxury automobiles from those simply interested in motor additives and repair tools" (Col 1, Lines 30-40). "The invention, in part, provides for the precise broadcasting of composite programs to targeted audiences. This requires that the base program content, e.g., the movie, the sports-cast, etc., is decoupled from the program fill, e.g., advertisements, public notices, stations breaks, video text overlays, private data, and so forth. Then, each target audience, while viewing the same base program, can be exposed to tailored fill material during program breaks, the fill material especially designed to appeal to the various target audiences based on their diverse demographics." (Col 4, Lines 10-19).

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In regard to claim 21, Bryant discloses gathering subscriber characteristics of the target group and determining a correlation between the subscriber group and the subavails. "The memory buffer 230 can also store data which is a "profile" of the customer demographics, e.g., age, income, location, etc. The profile can be used to selectively decode the broadcast signals as explained below" (Col 4, Lines 2-5).

In regard to claim 27, discloses that the subavails are grouped by combining a plurality of time-sequenced subavails. "The segments are adjacently arranged in a temporal manner, substantially without overlap, and with the base and fill segments alternating" (Col 4, Lines 48-50).

In regard to claim 29, Bryant discloses a system and method of distributing demographically targeted advertisements. The claimed limitation of "an advertisement opportunities (avails) recognition module configured to recognize avails, each avail having an expected viewership" is met by Figure 1. "Program segments 310 and 320, according to the invention, can be inserted or selected at points 110, 111, 120, 131, 140, 150, 160, 170 of the network 100" (Col 5, Lines 23-25). By inserting the program segments 310 and 320, the system inherently recognizes the advertisement opportunities. The claimed limitation of "a subavail generation module for creating a plurality of subavails based on the recognized avails" is met by Figure 1. "The segments are adjacently arranged in a temporal manner, substantially without overlap, and with the base and fill segments alternating" (Col 4, Lines 48-50). "The different fill segments 320 can be separately identified" (Col 5, Lines 10-11). "In a preferred embodiment of the invention, the segments 310 and 320 are separately identified as

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described below. During distribution of the program, the broadcaster or cable operator can insert segments and select segments based on the identification of the segments. If the selection is done in the STB 200, individual customers can be targeted" (Col 5, Lines 34-39). The claimed limitation of "a grouping module configured to create one or more groups of subavails by aggregating the plurality of subavails, wherein at least one of the groups of subavails has an expected viewership greater than or equal to the expected viewership of one of the avails" is met by Figure 3. "It is proposed that multiple fill segments be concurrently carried on the circuit assigned to the program during their allocated time periods" (Col 5, Lines 4-6). Therefore, the fill segments or "subavails" are grouped. Bryant discloses the use of targeted advertisements. A targeted advertisement is used to reach a specific audience so as to use the advertisement time as efficiently as possible. It is implicit that a targeted advertisement segment group will have an expected viewership greater than or equal to the expected viewership of any one segment. The "selection of the audience is primarily done by carefully matching advertisements, and other inserted content with a continuing base program. The hope is that audiences are more likely to watch inserted advertisements which closely match the base program content. For example, household products are frequently marketed during soap operas. Likewise, advertisements for motor products are usually matched with motor sports programs. However, the broadcaster has no way to separate audiences interested in new luxury automobiles from those simply interested in motor additives and repair tools" (Col 1, Lines 30-40). "The invention, in part, provides for the precise broadcasting of composite programs to targeted



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audiences. This requires that the base program content, e.g., the movie, the sports-cast, etc., is decoupled from the program fill, e.g., advertisements, public notices, stations breaks, video text overlays, private data, and so forth. Then, each target audience, while viewing the same base program, can be exposed to tailored fill material during program breaks, the fill material especially designed to appeal to the various target audiences based on their diverse demographics." (Col 4, Lines 10-19).

In regard to claim 31 and 32, Bryant discloses gathering subscriber characteristics of the target group and determining a correlation between the subscriber group and the subavails. "The memory buffer 230 can also store data which is a "profile" of the customer demographics, e.g., age, income, location, etc. The profile can be used to selectively decode the broadcast signals as explained below" (Col 4, Lines 2-5).

In regard to claim 34, discloses that the subavails are grouped by combining a plurality of time-sequenced subavails. "The segments are adjacently arranged in a temporal manner, substantially without overlap, and with the base and fill segments alternating" (Col 4, Lines 48-50).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19-20, 22-26, 28, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. in view of Eldering (WO 00/33163).

In regard to claim 19, Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose "selling the groups of subavails to one or more prospective advertisers". Eldering teaches selling advertisements opportunities to one or more advertiser so as to generate revenue for the content provider. "In a preferred embodiment of the present invention, a pricing policy can be defined. The content/opportunity provider 160 can charge advertiser 144 for access to consumer 100 during an opportunity" (Page 9, Lines 1-4). Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant to sell advertisements opportunities to one or more advertiser so as to generate revenue for the content provider.

In regard to claim 20, Eldering discloses that advertiser 144 send a bid to the content provider as shown in Figure 7. "Advertiser 144 transmits a bid contained within a bid message 730. The bid represents the amount that an advertiser is willing to pay for a transmission opportunity" (Page 23, Lines 7-9). Eldering also discloses selling the advertisement opportunity to the highest bidder. "Once the content/opportunity provider 160 has determined an acceptable bid, an acceptance message 740 is sent to advertiser 144" (Page 23, Lines 20-22). Where acceptable bit is interpreted to be the highest bid.

In regard to claim 22, Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose the

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"determining pricing for the groups of subavails based on the correlation". Eldering teaches determining pricing for the groups of subavails based on the correlation so as to maximize revenue for the content provider. The "price charged for access to consume 100 by content/opportunity provider varies as a function of the applicability of the advertisement to consumer 100" (Page 9, Lines 5-8). Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant with determining pricing for the groups of subavails based on the correlation so as to maximize revenue for the content provider.

In regard to claim 23, it is inherent that that the groups of subavails are sold based on the determined pricing. The "price charged for access to consume 100 by content/opportunity provider varies as a function of the applicability of the advertisement to consumer 100" (Page 9, Lines 5-8).

In regard to claim 24, the Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose the claimed steps of "transmitting the correlation results to one or more prospective advertisers", "receiving one or more bids for each group of subavails" and "selling the group of subavails to the highest bidder". The Eldering reference teaches the steps of "transmitting the correlation results to one or more prospective advertisers", "receiving one or more bids for each group of subavails" and "selling the group of subavails to the highest bidder" as show in Figure 7 so as to maximize revenue for the content provider. "As illustrated in FIG. 7, the combined correlation and pricing/fee message 720 is received by content/opportunity provider 160, who transmits the correlation result to

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advertiser 144" (Page 22, Lines 33-34; Page 23, Lines 1-2). "Advertiser 144 transmits a bid contained within a bid message 730. The bid represents the amount that an advertiser is willing to pay for a transmission opportunity. In a preferred embodiment the bid is calculated by advertiser 144 based on the results of the correlation" (Page 23, Lines 7-11). The claimed step of "selling the group of subavails to the highest bidder" is implied. Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant with the steps of "transmitting the correlation results to one or more prospective advertisers", "receiving one or more bids for each group of subavails" and "selling the group of subavails to the highest bidder" so as to maximize revenue for the content provider.

In regard to claim 25, the Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose the claimed steps of "receiving information about one or more advertisements to be placed in the subavails", "characterizing the advertisements" and "correlating the advertisements and the subscriber groups, whereby the advertisements are inserted in the subavails based on the correlation". The Eldering reference teaches the steps of "receiving information about one or more advertisements to be placed in the subavails", "characterizing the advertisements" and "correlating the advertisements and the subscriber groups, whereby the advertisements are inserted in the subavails based on the correlation" as show in Figure 7, so as to maximize revenue for the content provider. The claimed step of "receiving information about one or more advertisements to be placed in the subavails" is met by Figure 7. "Advertiser 144 then transmits an ad characterization

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710. The ad characterization can be received by content/opportunity provider 160 or directly by profiler 140" (Page 22, Lines 6-9). The claimed step of "characterizing the advertisements" is met by Figure 7. "Profile 140 retrieves consumer characteristics which can be in the form of probabilistic information regarding the consumer, deterministic data regarding the consumer, or product preference information" (Page 22, Lines 21-24). The claimed step of "correlating the advertisements and the subscriber groups, whereby the advertisements are inserted in the subavails based on the correlation" is also met by Figure 7. "Profiler 140 performs a correlation operation, the results of which are transmitted as a correlation factor or other correlation result to content/opportunity provider 160. In a preferred embodiment a pricing/fee arrangement message which represents the price for providing the advertisement as well as a fee for performing the correlation or accessing the consumer profile is transmitted along the correlation result" (Page 22, Lines 25-32). Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant with the steps of "receiving information about one or more advertisements to be placed in the subavails", "characterizing the advertisements" and "correlating the advertisements and the subscriber groups, whereby the advertisements are inserted in the subavails based on the correlation" so as to maximize revenue for the content provider.

In regard to claim 26, the combined teaching fails to explicitly disclose that the subavails are grouped by combining a plurality of subavails across different channels. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known to group plurality of advertisements across different channels so as to increase the chance

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of the profiled subscriber receiving the targeted advertisement over a channel range. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify the combination of Bryant and Eldering to have subavails that are grouped by combining a plurality of subavails across different channels so as to increase the chance of the profiled subscriber receiving the targeted advertisement over a channel range.

In regard to claim 28, the combined teaching fails to explicitly disclose that the subavails are gathered from the same channel. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known to have advertisements that are gathered from the same channel so as to increase the chance of the profiled subscriber receiving the targeted advertisement over time. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify the combination of Bryant and Eldering to have subavails that are gathered from the same channel so as to increase the chance of the profiled subscriber receiving the targeted advertisement over time.

In regard to claim 30, Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose "selling the groups of subavails to one or more prospective advertisers". Eldering teaches selling advertisements opportunities to one or more advertiser so as to generate revenue for the content provider. "In a preferred embodiment of the present invention, a pricing policy can be defined. The content/opportunity provider 160 can charge advertiser 144 for access to consumer 100 during an opportunity" (Page 9, Lines 1-4). Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant to sell

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advertisements opportunities to one or more advertiser so as to generate revenue for the content provider.

In regard to claim 33, the combined teaching fails to explicitly disclose that the subavails are grouped by combining a plurality of subavails across different channels. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known to group plurality of advertisements across different channels so as to increase the chance of the profiled subscriber receiving the targeted advertisement over a channel range. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify the combination of Bryant and Eldering to have subavails that are grouped by combining a plurality of subavails across different channels so as to increase the chance of the profiled subscriber receiving the targeted advertisement over a channel range.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

June 9, 2005

  
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SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600